



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,656	11/20/2000	Robert Senn	PI/5-20835B/C1	8378

7590 10/11/2002

William A. Teoli, Jr.
Syngenta Crop Protection, Inc.
Patent and Trademark Dept.
410 Swing Road
Greensboro, NC 27409

EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 10/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/716,656

Applicant(s)

Senn et al

Examiner

Alton Pryor

Art Unit

1616



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 22, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-32 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit:

Claim Rejections under 35 U.S.C. 103(a)

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 23-30,32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colliot et al (WO 9512314; 5/11/95) and Morie et al (JP 07224062; 8/22/95) . Colliot teaches an insecticide composition comprising fipronil. Colliot teaches a method of applying fipronil to plants to control insect infestation. See abstract. Colliot does not teach the composition / method comprising a 5-(chlorothiazol-5-ylmethyl)-3-methyl-4-nitroimino-perhydro-1,3,5-oxadiazine. However, Morie teaches an insecticide composition comprising 5-(chlorothiazol-5-ylmethyl)-3-methyl-4-nitroimino-perhydro-1,3,5-oxadiazine. See abstract. It would have been obvious to one having ordinary skill in the art to combine the prior art compositions. One would have been motivated to do this since both prior art inventions individually teach insecticide compositions.
3. Claims 23,31,32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colliot et al (WO 9512314; 5/11/95) and Matsuo et al (JP 08291171; 11/5/96) . Colliot teaches an insecticide composition comprising fipronil. Colliot teaches a method of applying fipronil to plants to control insect infestation. See abstract. Colliot does not teach the composition / method

Art Unit:

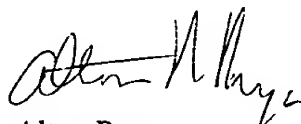
comprising a nitroiminoperhydro-1,3,5-oxadiazine. However, Matsuo teaches an insecticide composition comprising a nitroiminoperhydro-1,3,5-oxadiazine compound. Matsuo teaches a method of applying said compound to plants (herbicide) to control insect infestation. See abstract. It would have been obvious to one having ordinary skill in the art to combine the prior art compositions. One would have been motivated to do this since both prior art inventions individually teach insecticide compositions.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton Pryor whose telephone number is (703) 308-4691. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Alton Pryor

Primary Examiner, AU 1616

10/10/02

Art Unit: 1616

Applicant's arguments with respect to claims 23-30,32 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections under 35 U.S.C. 103(a)

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 23-30,32,33 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Davidson et al (5614182; 3/25/97) and Moriie et al (JP 07224062; 8/22/95) . Davidson teaches

✓ that fipronil is an insecticide. Davidson teaches a method of applying fipronil to an insect's

environment to attract and kill the insect. See abstract, column 3 lines 53 - column 4 line 42.

✗ Davidson does not teach 5-(chlorothiazol-5-ylmethyl)-3-methyl-4-nitroimino-perhydro-1,3,5-

oxadiazine as an insecticide. However, Moriie teaches that 5-(chlorothiazol-5-ylmethyl)-3-methyl-

4-nitroimino-perhydro-1,3,5-oxadiazine is an insecticide. See abstract. It would have been

obvious to one having ordinary skill in the art to combine the prior art compositions. One would

have been motivated to do this since both prior art inventions individually teach insecticides.

3. Claims 23,32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davidson et

al above and Matsuo et al (JP 08291171; 11/5/96) . Davidson teaches that fipronil is an

Art Unit: 1616

✓ insecticide. Davidson teaches a method of applying fipronil to an insect⁵ environment to attract and kill the insect. See abstract, column 3 lines 53 - column 4 line 42. Davidson does not teach 5-(chlorothiazol-5-ylmethyl)-3-methyl-4-nitroimino-perhydro-1,3,5-oxadiazine as an insecticide. Davidson does not teach ~~nitroiminoperhydro~~ nitroiminoperhydro-1,3,5-oxadiazine as an insecticide. However, Matsuo teaches that nitroiminoperhydro-1,3,5-oxadiazine is an insecticide. Matsuo teaches a method of applying said compound to an insect environment to control insect infestation. See abstract. It would have been obvious to one having ordinary skill in the art to combine the prior art active compounds to form a single composition. One would have been motivated to do this since both prior art inventions individually teach insecticidal compositions.

Claim Objection

Claim 31 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not suggest a method of applying instant compositions onto ✓ plant⁵ or plant propagation material⁵.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton Pryor whose telephone number is (703) 308-4691. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

Art Unit: 1616

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Alton Pryor

Primary Examiner, AU 1616

5/31/03